

**REMARKS**

Applicant directs the Examiner's attention to the Information Disclosure Statement filed concurrently herewith.

Applicant respectfully requests Examiner Noori to reconsider and withdraw the rejection of claims 1-12 under 35 U.S.C. § 112, second paragraph, in view of the above corrective amendments to claims 1, 11 and 12, which amendments insert the words which the Examiner states "should be used to convey the related meaning".

In addition, and in response to the last sentence in paragraph 5 of the Office Action under the heading "Response to Amendment", Applicant has amended the written description in two selected paragraphs to clarify any confusion which may have existed because of the interchangeable use of various forms of the words "deflected" and "displaced". It is believed that the amended written description will eliminate any confusion which the Examiner sees in the originally filed written description.

More specifically, since the motion of a push rod (21) was described as both a displacement and a deflection, it is now clear that these terms are used interchangeably in the written description. Similarly, since the motion of the "testing element 20" is described as a "movement", "displacement" or "deflection", the above amendments to the specification make it clear that these terms are used interchangeably.

Thus, in view of these clarifying amendments to the early part of the written description, Applicant respectfully submits that the later descriptions of the motions of the push rods 21 and the testing element 20 are quite understandable.

Applicant respectfully traverses the double-patenting rejection of claims 1, 2, 11-13 as being unpatentable (obvious) over claims 1 and 4 of the common assignee's earlier issued patent Focke '138 (which is cited on pages 1 and 3 of Applicant's specification as known prior art).

In view of the above amendments to overcome the rejection of 35 U.S.C. § 112, second paragraph, it is assumed that the remaining (dependent) claims 3-10 and 14-21 would be **allowable if rewritten in independent form**; however, Applicant wishes to hold in abeyance such rewriting until the Examiner has had an opportunity to reconsider (and withdraw) the double-patenting rejection of claims 1, 2 and 11-13.

In support of this double-patenting rejection, the Examiner makes the following curious statement (page 3, paragraph 4 of the Office Action):

Although "138" discloses the detail of the specific sensing devices in terms of generation of electric, magnetic or electromagnetic, it would have been obvious for a skilled artisan at the time of the invention to use any kind of suitable sensor for the **detection of the position of push rod** for convenience.

This statement leads Applicant to the conclusion that the Examiner may not have appreciated the difference between the disclosure/claimed invention of Focke '138 and the subject matter of Applicant's present claims 1, 2 and 11-13, as the present claimed invention has **nothing** whatsoever to do with detecting the position of the **push rods 21**, but exclusively with detecting the position of the **testing elements 20** (called "checking devices 18" in Focke '138) at the very moment when a push rod 21 generates an actuation signal upon making contact with a testing element, in particular a cigarette! The claims and disclosure of Focke '138 contain **no** reference to detecting the position of the **testing elements 20**.

The disclosure and claims of Focke '138 relate only to **which means** can be employed to generate actuation signals as soon as the individual push rods 21 are displaced from their resting position by cigarettes. Applicant's present invention, on the other hand, is directed to the **evaluation** of the actuation signals generated in this manner. To this end, the position of a testing element 20, in which the push rods 21 are arranged, is detected in each case as soon as an actuation signal is generated. Accordingly, a value pattern can be plotted which compares each position of the testing element 20 with the corresponding number of actuation signals generated by the individual push rods 21. By evaluating this value diagram, it is possible, for example, to establish whether the length of a certain number of cigarettes is larger than a predetermined desired value. This is **not at all possible** with the teachings or disclosure of Focke '138 in which actuation signals are generated as soon as a cigarette is present at the respective test positions. Focke '138 cannot detect whether the actuation signal was triggered by cigarettes that may be too long.

Applicant now will specifically address the specific language/scope of Applicant's rejected claims 1, 2 and 11-13 relative to claims 1 and 4 of Focke '138.

a) Claim 1 of **Focke '138** teaches a method for checking cigarettes through the displacement of a push rod axially in the direction of a cigarette end of a cigarette formation. A corresponding actuation signal is generated depending on the position of the push rod, in particular depending on the depth to which a ferromagnetic and/or ferrimagnetic region of the push rod penetrates the interior of a coil. The depth of penetration of the magnetic region of the push rod into the coil depends on whether or not a cigarette is present at the position of checking.

Thus, the subject matter/scope of this claim 1 is a method which determines the respective positions of the **push rods** during the checking procedure.

In **contrast**, according to claim 1 of Applicant's **present** application, it is **not** the position of the **push rod 21** which is determined but, rather, and only, the position of a **testing element 20** having a **plurality of push rods**! Here, the **position of the testing element 20** is "**determined**" and "**evaluated**" during a single checking operation (during which the testing element 20 is moved in the direction of the cigarettes) as soon as a single push rod 21 generates an actuation signal by making contact with a cigarette.

Applicant respectfully asks the Examiner, how could the skilled artisan, with knowledge of claim 1 of Focke '138, arrive at the solution of Applicant's claim 1, in which, at the very moment that **each** signal is generated during a checking operation by a push rod 21, the position of the **testing element 20** is "**determined**" and "**evaluated**"? Claims 1 and 4 of Focke '138 contain no suggestions or references whatsoever that might lead the skilled artisan to "determine" and "evaluate" the position of the "testing element" 20 for each actuation signal generated by a push rod during a checking operation.

b) It is precisely Applicant's claimed determination and evaluation of the individual positions of the testing element 20 during a single checking pass which accounts for the success of Applicant's invention. In a special embodiment of the invention, a value diagram can be plotted by tracking **each position of the testing element 20** relative to the corresponding number of actuation signals generated by the individual push rods. By evaluating this value diagram, it is possible, for example, to determine whether the length of a certain number of cigarettes is greater

than a preset desired value. This is not at all possible with the teachings set forth in claim 1 (or 4) of Focke '138 in which actuation signals are always generated when a cigarette is present at the respective test position, regardless of the respective length of the cigarette itself. The teaching of Focke '138 is **incapable** of determining whether the cigarette at the checking position may be too long. The next step, whereby the position of the testing element 20 is to be determined each time the corresponding actuation signal is generated, is **completely lacking** from claim 1 (and 4) of Focke '138.

The above statements regarding "method" claim 1 of Focke '138 apply equally to the corresponding "device" claim 4 of Focke '138. Furthermore, the above statements referring to Applicant's independent "process" claim will apply equally to Applicant's independent "apparatus" claim 12 whose limitations track those of claim 1.

The above arguments explain why the subject matter of Applicant's present independent parent claims 1 and 12 would not have been obvious from the subject matter of claims 1 and 4 of Focke '138. These same arguments apply to Applicant's dependent claims 2, 11 and 13 as they contain additional limitations with respect to their respective parent claims 1 and 12 whose non-obviousness have already been shown above.

#### **REQUEST FOR INTERVIEW**

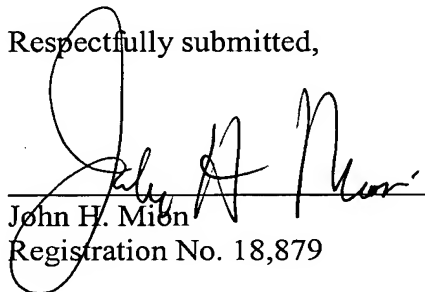
In summary, then, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 112, second paragraph, and the rejection based on obviousness-type double-patenting, and to find the application to be in condition for allowance with all of claims 1-21; however, if for any reason the Examiner feels that the application is not

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 10/700,059

now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Filed concurrently herewith is a Petition (with fee) for an Extension of Time of one month. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,



John H. Mion  
Registration No. 18,879

SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, D.C. 20037-3213  
(202) 663-7901

WASHINGTON OFFICE

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